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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,579	10/20/2003	Julio C. Palmaz	JOH2748P0044US	2120
32116	7590	05/01/2006	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/689,579	Applicant(s) PALMAZ ET AL.	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/7/06 + 4/19/06</u> | 6) <input type="checkbox"/> Other: _____ |

Reissue Applications

Subsequent to the telephone conversation with Joel Siegel on April 24, 2006, the Examiner determined that the proposed Examiner's Amendment would require a supplemental oath or declaration because it is substantive in nature. The Examiner regrets any inconvenience that this late discovery may cause the Applicant.

While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5,102,417 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

Specification

Upon review of the specification amendment filed April 7, 2006, certain underlining, probably inadvertent, is present on the scanned version of the replacement paragraph; see line 7. In addition, the two periods surrounding "TM" have been underlined since they were not in the original paragraph; see line 5 of the replacement paragraph and compare to the patented paragraph on column 11, lines 3-34.

Claim Objections

Claims 45 and 65 are objected to because of the following informalities:

In claims 45 and 65, on line 2 of each claim, the language "that comprises" constitutes improper Markush language; see MPEP 2173.05(h). This language should be replaced with ---consisting of--- in order to be in agreement with accepted Markush language format. Appropriate correction is required.

Because the changes to the claims is a substantive change, a supplemental oath or declaration will be required.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-65 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

Art Unit: 3738

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Allowable Subject Matter

Claims 1 to 65 would be allowed once the above objections are overcome and once a supplemental oath or declaration is provided.

The following is an examiner's statement of reasons for allowance:

Upon review of the prior art of record, the Examiner determined that the Ersek patent was the closest to the present claimed invention. However, it was determined that Ersek lacks either a catheter (see the definitions of a catheter cited on the enclosed PTO-1449) or a connector "flexibly connecting adjacent prostheses." In particular, the catheter as claimed is not met by the tool (18) because it lacks the structure and/or function of a tubular instrument that allows passage of fluid from into or from a body cavity; instead, the tool is not designed to allow fluid to flow through it but is designed to transfer mechanical forces to the implant. Additionally, the flexible connectors of Ersek (see Figures 3 and 4) do not clearly "flexibly connect adjacent prostheses to each other" as it is being interpreted by the Examiner because the connection provided by Ersek is not one that clearly "provides flexibility to negotiate bends and curves in the vascular system"; see the specification on column 3, lines 35-36 and lines 62-68. For this reason, the Examiner asserts that any flexibility inherently provided by Ersek's "connectors" (wire struts (28) [Figure 4] or meshes between openings (25) [Figure 3]) is not clearly sufficient to meet the claim language for flexible connectors as the Examiner is interpreting such. For these reason, Ersek was not considered sufficient to anticipate or render obvious the claim language.

Witkor (US 4,969,458) was considered to be the second closest prior art document of record. However, Witkor lacked at least slots parallel to the longitudinal axis and flexible connectors as understood by the Examiner; see supra.

Wallace et al (Radiology 1986 158: 309-312) and Charnsangavej et al (Radiology 1986 161:295-298) did not have the controlled expansion characteristics as claimed or the inflatable catheter to expand the graft as required. For these reason, they were not considered sufficient to anticipate of render obvious the present claims.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Paul B. Prebilic
Primary Examiner